

*Appl. No. 09/994,634
Reply to Office Action Dated March 16, 2006*

REMARKS

Claims 1-3, 5-14, and 21-27 are currently pending in the application. Claims 1, 9 and 25 are independent. No new matter has been added to the claims. Applicants respectfully request reconsideration of the present application.

Rejection of Claims 1-3 and 7-8

Claims 1-3 and 7-8 stand rejected as being unpatentable over Singkornrat in view of Jung and further in view of Stiner (Pub. No. US 2005/0133650). Applicant respectfully disagrees.

With respect to claim 1, claim 1 is patentable over Singkornrat in view of Jung and further in view of Stiner because, in the very least, none of the references, considered alone or in combination, disclose all of the features of claim 1. As the Office correctly noted, Singkornrat and Jung fail to teach a display driver that is "configured to translate data between the monitor wireless transceiver and the computer display device," as is required by claim 1. The Office contends that this feature of claim 1 is disclosed by Stiner and that it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teaching of Stiner with those of Singkornrat and Jung. The Office's contention lacks merit for at least three reasons: (1) Stiner does not teach or suggest a display driver configured to translate data between a wireless transceiver and a display device; (2) Stiner is non-analogous to the invention claimed; and (3) the Office has not provided any suggestion or motivation to combine the references and there appears to be no such suggestion or motivation.

(1) Stiner Does Not Teach or Suggest the Claimed Display Driver.

Contrary to the Office's contention, Stiner does not teach or suggest a "display driver configured to translate data between the monitor wireless transceiver and the computer display device," as is required by claim 1. The Stiner application teaches a display driver operating between a controller and a display device to "translate data provided by the controller into information visually presented to a user by the display" (col. 6, claim 11 and Fig. 4) (emphasis added). Claim 1, on the other hand, requires a "display driver configured

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to translate data between the wireless transceiver and the computer monitor device” (emphasis added). Critically lacking from Stiner is any mention of a wireless transceiver. Indeed, because Stiner’s controller and display are taught as comprising one functional unit, there would be no need for a wireless transceiver. Accordingly, Stiner does not disclose the claimed display driver (i.e., a display driver that is configured to translate data between a wireless transceiver and a computer monitor device). Thus, even if Stiner were combined with the other references, the combination would not achieve the invention as defined by claim 1.

(2) Stiner is Non-Analogous Prior Art.

Stiner may not be used as a prior art reference under §103 because it is non-analogous. See MPEP §2141.01(a); State Contr. & Eng'g Corp. v. Condotte Am., Inc., 346 F.3d 1057, 1069 (Fed. Cir. 2003); Wang Lab. v. Toshiba Corp., 993 F.2d 858, 864 (Fed. Cir. 1993); In re Clay, 966 F.2d 656, 658-659 (Fed. Cir. 1992). Courts have established a two-pronged test to determine whether prior art is analogous:

Two criteria are relevant in determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the art is not within the same field of endeavor, whether it is still reasonably pertinent to the particular problem to be solved.

Wang Labs, 993 F.2d at 864. Applying this test to Stiner establishes that Stiner is not analogous prior art. Under the first prong, prior art must be in the same field of endeavor. A fishing reel mechanism, however, is completely different from a wireless computer monitor; they are different technologies and used for different purposes. Thus the first prong is not met under the Wang Labs test because a fishing reel is in a different field of endeavor than a wireless computer monitor.

A piece of prior art may still be asserted as analogous under Wang Labs’ second prong if it is reasonably pertinent to the particular problem to be solved. A fishing reel mechanism, however, is not pertinent to the problem of how to establish communication between a computer and a wireless monitor. Thus the second prong of the Wang Labs test is not satisfied.

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(3) The Office Has Provided No Suggestion or Motivation to Combine Stiner with the Other References

There is no suggestion or motivation to combine Stiner with the other references. In order for the Office to establish a *prima facie* case of obviousness, there must be "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP §2143; see also In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006) (noting that "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole").

In this case, the Office seeks to modify Jung to incorporate the teachings of Stiner with regard to a display driver that translates data provided by a controller. But, the Office has failed to articulate why a person of ordinary skill in the art would be motivated to make the modification. The Office's failure to provide any suggestion or motivation to combine the references¹ is unsurprising because none exists.

Both Jung and Singkornrat provide fully functional means to present information visually to a user, and they do so without requiring a display driver configured to translate data for the display. Accordingly, incorporating the display driver of Stiner into Jung or Singkornrat would provide no added advantage. In fact, incorporating the Stiner display driver into the system disclosed in Jung would make the system more complex and costly without adding any benefit. Thus there is no suggestion or motivation to combine Stiner with the other references.

In conclusion, the office action has failed to establish a *prima facie* case for obviousness because: (1) the cited prior art references fail to teach or suggest all of the elements of claim 1; (2) Stiner is non-analogous prior art; and (3) there is no suggestion or motivation to combine the references.

Applicant, therefore, respectfully requests that the rejection of claim 1, and claims 2-3 and 7-8, which depend from claim 1, be withdrawn.

¹ When the Office fails explain a suggestion or motivation to combine, the Federal Circuit has held that it will assume that the Office has improperly used hindsight in coming to the conclusion of obviousness. See e.g. In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006).

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Rejection of Claim 9-11, 21-23

Claims 9-11, and 21-23 stand rejected as being obvious over Singkornrat in view of Schindler (US 5,867,223). Applicant respectfully disagrees.

With respect to claim 9, the Office has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Office must establish the following three elements:

[F]irst, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143. Because the Office Action failed to establish the existence of at least two of these criteria, rejection of claim 9 under §103(a) is improper.

As an initial note, Applicant would like to suggest that the Office has failed to provide any suggestion or motivation to combine the teaching of Schindler with that of Singkornrat. The Federal Circuit has noted that “when the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious.” In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006).

Additionally, even if there were a suggestion or motivation to combine the prior art, the prior art cited does not teach or suggest all the claim limitations of the rejected claims. The Office correctly states that Singkornrat “fails to teach a unique address for wireless communication.” The Office incorrectly contends, however, that Schindler makes up for the deficient teachings of Singkornrat.

Schindler does not teach or suggest a “wireless communication [that] includes... said unique address [of the computer main unit],” as is required by claim 9. Instead, Schindler simply discloses a system having a plurality of wireless headphones and speakers. Each headphone/speaker is tuned to a unique RF transmitter, which broadcasts at a particular frequency and is uniquely addressable, so that audio data can be selectively transmitted to only one of the headphones/speakers. However, the headphones/speakers do

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not have a transmitter for transmitting data to a computer main unit. Accordingly, by definition, the headphones/speakers are incapable of "transmitting a wireless communication to [a] computer wireless transceiver, wherein said wireless communication includes data and said unique address [of the computer main unit]," as is recited in claim 9. In other words, the data flow to the headphones is unidirectional whereas claim 9 requires a bi-directional data flow. Accordingly, Shindler does not teach or suggest a "wireless communication that includes the unique address [of the computer main unit]," as is required by claim 9. For this reason alone, the rejection of claim 9 should be withdrawn.

In sum, the Office has failed to make a *prima facie* case of obviousness with respect to claim 9 because neither Singkornrat nor Schindler, considered alone or in combination, teach or suggest all the claim limitations. Additionally, there is also no evidence offered that the combination of the Singkornrat and Schindler patents was suggested or motivated by the prior art references.

Applicant, therefore, respectfully requests that the rejections of claim 9 and claims 10-11 and 21-23, which depend from claim 9, be withdrawn.

Rejection of claims 25-26

Claims 25-26 stand rejected as being unpatentable over Riazi (US 6,748,005) in view of Jung (U.S. Patent. No. 6,041,225) and further in view of Stiner (Pub. No. US 2005/0133650). Applicant respectfully traverses.

With regard to claim 25, claim 25 is patentable over Riazi in view of Jung and further in view of Stiner because neither Riazi nor Jung nor Stiner, considered alone or in combination, disclose all of the elements of claim 25. As the Office correctly noted Riazi and Jung fail to teach a display driver configured to translate data for the display². The Office then improperly relies upon Stiner for the elements of claim 25 that remain untaught by Riazi and Jung. As noted in the discussion relating to the rejection of claim 1, *supra*, this assertion is untenable. Accordingly, Applicant respectfully requests that the rejections of claim 25 and claim 26, which depends from claim 25, be withdrawn.

² The Office actually notes that Singkornrat and Jung, in combination, fail to teach this element, but Applicant assumes this is an error as Singkornrat was not a basis for the rejection of claim 25.

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Rejection of Claim 5-6

Claims 5-6 depend from claim 1, and, therefore, are patentable for at least the reason given above with respect to claim 1.

Rejection of Claims 12-13, 14 and 24

These claims depend from claim 9, and, therefore, are patentable for at least the reason given above with respect to claim 9.

Rejection of Claim 27


Claim 27 depends from claim 25, and, therefore, is patentable for at least the reason given above with respect to claim 25.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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